

**REMARKS**

**Status of the Application**

Claims 1-13 are all the claims pending in the application. Claims 1-3 and 6-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Valero (US Publication 2003/0081038) in view of Valero (US Patent 6,802,580) and Yamada (US Patent 6,726,302). Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Valero (US Publication 2003/0081038) as modified by Valero (US Patent 6,802,580) and Yamada (US Patent 6,726,302) as applied to claim 1 above, and further in view of Williams (US Patent 6,164,749). Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Valero (US Publication 2003/0081038) as modified by Valero (US Patent 6,802,580) and Yamada (US Patent 6,726,302) as applied to claim 1 above, and further in view of Butterfield (US Patent 6,685,297).

**Claim Rejections- 35 U.S.C. § 103**

*Claims 1-3 and 6-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Valero (US Publication 2003/0081038) in view of Valero (US Patent 6,802,580) and Yamada (US Patent 6,726,302).*

Claim 1 recites, in part, “determining whether or not to form said adjustment pattern again with said liquid ejecting section” and “the position having been selected from a plurality of positions by a user.” The Examiner alleges that a combination of Valero ‘038, Valero ‘580 and Yamada renders claim 1 obvious. Applicants respectfully disagree, as there is no motivation to combine the references as alleged by the Examiner.

The Examiner alleges that one of ordinary skill in the art would be motivated to combine the references as proposed because "[w]ith the user selecting the position of the test pattern this would reduce complexity of the controller and reduce cost" (See page 6, lines 17-18 of the Office Action).

Applicants respectfully disagree. The user selecting the position of the test pattern as disclosed in the Valero references would actually increase complexity of the controller and increase cost. In order to make it possible that the user selects the position of the test pattern, the controller must include a user interface for the selection, make commands for controlling the position of the print head according to the position which the user selected, and check whether or not the position which the user selected is within the printing area among other operations. On the other hand, in the case where the position of the test pattern is fixed (i.e. the user can not select the position of the test pattern), the controller performs the same operation without performing any of the operations pertaining to the user's intervention, resulting in lower cost and complexity.

Therefore, because the Examiner's motivation to combine to references is deficient to render claim 1 obvious, claim 1 is patentable over the applied art. Claims 2, 3 and 7-10 are patentable at least by virtue of their dependency from amended claim 1. Claims 11-13 recite similar limitations to claim 1, and are patentable for reasons analogous thereto.

*Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Valero (US Publication 2003/0081038) as modified by Valero (US Patent 6,802,580) and Yamada (US Patent 6,726,302) as applied to claim 1 above, and further in view of Williams (US Patent 6,164,749).*

Claim 4 depends from claim 1. Because the Examiner's proposed combination of Valero '038, Valero '580 and Yamada fails to render claim 1 obvious, and because Williams fails to cure the deficiency in the Examiner's proposed combination noted above, claim 4 is patentable at least by virtue of its dependency from claim 1.

*Claim 5 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Valero (US Publication 2003/0081038) as modified by Valero (US Patent 6,802,580) and Yamada (US Patent 6,726,302) as applied to claim 1 above, and further in view of Butterfield (US Patent 6,685,297).*

Claim 5 depends from claim 1. Because the Examiner's proposed combination of Valero '038, Valero '580 and Yamada fails to render claim 1 obvious, and because Butterfield fails to cure the deficiency in the Examiner's proposed combination noted above, claim 5 is patentable at least by virtue of its dependency from claim 1.

### **Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.111  
Application No.: 10/764,599

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

/Dion R. Ferguson/

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER

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Dion R. Ferguson  
Registration No. 59,561

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